IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.3528 OF 2003
IN
SUIT NO.3725 OF 2003

Manek Chand Jain & Anr. ....Plaintiffs
V/s.
Cello Pens & Stationery Pvt.Ltd. ....Defendant

Mr.Shekhar Shetye i/b Gajaria & Co. for the Plaintiffs.

Mr.Virag Tulzapurkar, Senior Counsel with Mr.Salil Shah, Mr.H.J. Engineer & Ms.Rupal Narielwala i/b Gordhandas & Fozdar for the Defendant.

CORAM: S.J.VAZIFDAR, J.
DATED: 18TH SEPTEMBER, 2006.

P.C. :

1. The suit is filed to restrain the Defendant from selling or offering for sale writing instruments as shown in Exhibit "D-2" and/or applying the Plaintiffs registered designs described in Exhibits "B-1", "B-2" and "B-3" to the plaint or any other identical or deceptively similar design/designs to writing instruments, caps or ball pens or other goods falling in Class 16-09 of the Designs Act, 2000 and Designs Rules, 2001 so as to infringe the Plaintiffs' registered designs. The suit is also filed to restrain the Defendant from passing off its goods as and for the

goods of the Plaintiffs by manufacturing, packing or selling the said goods or any other goods bearing the trade mark "Pin Point" or design or get up described in Exhibit "D-2" to the plaint or any other mark, design or get up identical or deceptively similar to the Plaintiffs' products described in Exhibit "D-1" to the plaint. The suit is also filed for infringement of the trade mark "Pin Point" as and when the same is registered. The Notice of Motion is for usual reliefs in an action for infringement and passing off.

2. Plaintiff No.2 was incorporated in 1990 and claims to be a pioneer of gel ink pens. Plaintiff No.1 is the Managing Director of Plaintiff No.2. Plaintiff No.2 claims to be the largest producer of plastic ball pens in India.

3. The Plaintiffs' case is that in or around June, 2001, Plaintiff No.1 conceived a new and original design/ornamentation and pattern in respect of a ball pen. On 11.6.2001, Plaintiff No.2 applied for and was granted registration of the design under the Designs Act, 2000 in respect of ball pens in Class 19-06 of schedule 3 of the Design Rules, 2001. The registration certificate states that the novelty resides in the shape and configuration of the ball pen as illustrated.

The registration certificate also records aspects in respect whereof no claim is made by virtue of the registration which includes claims in respect of colour and colour combination appearing in the design.

. The Plaintiffs also claim that Plaintiff No.1 conceived another new and unique design or ornamentation and pattern in respect of the writing instrument cap. The design in respect thereof was registered on 30.1.2002. The registration certificate states that the novelty resides in the shape and configuration of the writing instrument cap as illustrated. Similar statements as in the case of the first registration are contained in the certificate of registration. In addition the certificate states that no claim is made by virtue of the registration in respect of the use of words, letters, numbers or trade marks endorsed on the representation sheet.

. The Plaintiffs further claim that Plaintiff No.1 conceived yet another new and unique design/ornamentation or pattern in respect of the writing instrument barrel. The design was registered on 4.4.2002. The certificate does not contain any qualification as in the case of the earlier registration and certificates.

4. Plaintiff No.1 permitted Plaintiff No.2 to apply for the registration of the aforesaid three designs in respect of the said products.

5. The Plaintiffs' case is that Plaintiff No.2 applied such designs to its products and has been selling the same since August, 2002 extensively all over the country ; that the products are advertised in various places and that the turnover and advertisement, sales promotion and marketing expenses from the year 1998 to 2003 of their various products are substantial as stated in paragraph 7 of the plaint.

6. It is important to note however that the sales figures pertain to the products bearing the said designs and not products bearing the trade mark "Pin Point". The Plaintiffs have furnished details of the sales turnover of the products bearing the said designs referred to in Exhibits "B-1", "B-2" and "B-3" for the year August, 2002 to 31.10.2003 of an aggregate sum of almost Rs.4,36,00,000/-. Once again it is pertinent to note that the sales turnover figures pertain to the products bearing the said designs and not to the products bearing the said trade mark "Pin Point".

7. Thus the Plaintiffs have claimed infringement of their said designs and passing off on the basis of the designs together with the use of the trade mark "Pin Point" and general get up of the product.

8. Mr.Tulzapurkar, the learned Senior Counsel appearing on behalf of the Defendant submitted that the Plaintiffs are not entitled to an injunction on the ground of infringement of the designs inter-alia in view of Sections 4(b), 19(1)(b) and 22(1), (2) and (3) of the Designs Act, 2000 which read as under :-

> **4. Prohibition of registration of certain designs.** - A design which -
>
> (b) has been disclosed to the public any where in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration;
>
> **19. Cancellation of registration.**- (1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely :-
>
> (b) that it has been published in India or in any other country prior to the date of registration;
>
> 22. Piracy of registered design. -

(1) During the existence of copyright in any design it shall not be lawful for any person -

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or

(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention -

(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be

> restrained by injunction accordingly: Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees: Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any court below the court of District Judge.
>
> (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

9. In support of its case of prior publication, the Defendant has in the affidavit in reply inter-alia stated that the normal trend of the pens industry in India is to procure samples from across the world including by visiting exhibitions on pens around the world and copying the designs. Though "copying" is not the word used in the affidavit that is really in substance the purport of the pleading. It is further stated that the Defendant itself also called for pamphlets and catalogues from foreign manufacturers of pens and stationery articles and from them selected the designs of pens for the purpose of manufacturing pens and selling them in the Indian market with some variation in designs. The Defendant’s Directors themselves visited foreign countries for this purpose.

10. So far as the present case is concerned, the Defendant's case is that one of its Directors one Pankaj Ghisulal visited various places in Korea in December, 2000 and brought with him amongst other things a pamphlet annexed as Exhibit "1" to the affidavit in reply. The pamphlet/brochure is one stated to be issued in the year 2000 by the company known as Kims Enterprises Co. Ltd., Korea. The affidavit goes on to state :-

> "I say that from the said pamphlet, the Defendants company selected particular design of model of pen under the name "Topink pen" and negotiated with the said company for adopting the said design. Accordingly, the said company agreed to allow the Defendants to manufacture the pens of similar design. Thereupon in or about January, 2001, the Defendants adopted the design of pen as shown in Ex.1 and thereafter got the mould prepared for manufacture of pen of the said model and thereafter started manufacturing and selling the said pens in India under the name Cello PIN POINT."

11. The only disputes are whether the pamphlet Exhibit "1" to the affidavit in reply is genuine and whether it was issued in the year 2000. If the pamphlet is genuine and had been issued in the year 2000 the defence must succeed for it is evident that the Defendant's product is not merely a similar but virtually an identical design as one of the products mentioned therein. In fact the defendant's product

shows minor variation from the Plaintiffs' product. Even these minor variations do not exist on a comparison of the Defendant's product and the product mentioned in Exhibit "1". This was not and indeed cannot be disputed by the Plaintiffs. It is unnecessary therefore to describe the identical features of the Defendant's product with the ones of the product depicted in the pamphlet Exhibit "1".

12. Prima-facie it is difficult to hold that the pamphlet Exhibit "1" is a got up document. It contains, apart from various models of pens, the detailed address, including the e-mail address and the phone numbers of the Korean Company. The pamphlet states that it pertains to "Millennium 2000 Collection" which indicates clearly the year of its publication.

13. When the averments in the affidavit in reply were denied, the Defendants filed an affidavit in sur-rejoinder and annexed thereto a copy of its Director's passport which establishes that he had in fact visited Korea during the relevant period viz. 4th December, 2000 to 7th December, 2000.

14. Mr.Shetye, the learned counsel appearing on behalf of the Plaintiffs submitted that the passport

indicates that the Defendant's Director was a frequent traveller abroad. He submitted that it was obvious therefore that the Defendant's Director was travelling abroad for some other purpose and not merely for the purpose of collecting the design of pens of other manufacturers. I do not agree with this line of reasoning. Merely because the person travelled abroad often it would not lead to the conclusion that he did so for purposes other than for obtaining the designs of pens of other manufacturers.

15. Mr.Shetye then submitted that the Defendant's product has on the clip the words "R & D Germany". Based on this, he submitted the Defendant's case that the design was from a Korean manufacturer is false.

16. This point has not been taken either in the plaint or in the affidavit in rejoinder. There could be a number of explanations for the same. In the absence of pleading, it would be unfair to permit the Plaintiffs to speculate in this regard.

17. It is true that in the affidavit in reply, though the Defendant had alleged that the Korean company agreed to allow the Defendant to manufacture products of a similar design, it did not produce the

alleged agreement. Considering the totality of circumstances however I am not inclined to grant the application on this ground. Even if no such permission was granted in law it would make no difference to the defence.

18. Considering the general get up of Exhibit "1", the details of the manufacturer mentioned therein and the fact that the Defendant's Director had visited Korea, prima-facie the Defendant's case that it had copied the design of one of the products depicted in Exhibit "1" must be accepted.

19. If I am correct in the above conclusion, two things follow. Firstly, the design of the Plaintiffs' pen which is alleged to have been infringed by the Defendant is not new or original as the same was already published in Korea prior to the date of the application for registration by the Plaintiffs. Secondly, the Defendant has clearly copied the product from Exhibit "1" and not the Plaintiffs' design. This is evident from the fact that the Plaintiffs product is identical to the one in Exhibit "1" to the affidavit in reply. Even assuming that it is deceptively similar to that of the Plaintiffs' design it resembles the product in Exhibit "1" merely closely.

20. The Plaintiffs are therefore not entitled to any reliefs based on their registered designs.

21. In this view of the matter it is not necessary for me to consider Mr.Tulzapurkar's further submission regarding the Plaintiffs' case of infringement of design. Suffice it to state in fairness to him that he had contended quite forcefully that the registration of the Defendant's designs are illegal and liable to be cancelled on other grounds such as under Section 4(a) and (c) read with Section 19(1)(c) and (d) of the said Act. Mr.Tulzapurkar contended that there was nothing new regarding the Plaintiffs' design entitling the Plaintiffs to have the design registered. He also addressed me in considerable detail regarding the scope of the expression shape and configuration used in the registration certificate. In view of the finding regarding prior publication, I do not consider it necessary in the present case to express any opinion on these and other arguments of Mr.Tulzapurkar.

22. The Plaintiffs had applied for registration of the trade mark "Pin Point". The mark was registered in April, 2005. Thus on the date of filing of the suit, the trade mark had not been registered. The plaint was

not amended after the Plaintiff obtained registration of the said trade mark. A registration certificate was tendered during the hearing. It would however not be fair to the Defendant to allow the Plaintiffs to base a claim on infringement of the registered trade mark as the Defendant has not had an opportunity to deal with the fact or consequence of such registration. The Plaintiffs are at liberty to adopt proceedings in view of the subsequent registration of the trade mark.

23. This bring me to the Defendant’s case of passing off. The Plaintiffs claim to have conceived and adopted the trade mark "Pin Point" in March/April, 1992 and used the same in respect of pens since 1992 on an extensive scale. The Plaintiffs claim that Plaintiff No.2 has acquired enormous good-will and reputation in the trade mark and the same is associated exclusively with Plaintiff No.2.

24. The sales figures referred to in paragraph 7 of the plaint pertain to all the products of the Plaintiffs and not merely those with the trade mark "Pin Point". Further the sales figures in respect of the pens bearing the registered designs at Exhibits "B-1", "B-2" and "B-3" pertain to the products of that design and not the products bearing the trade mark "Pin

Point". In this regard, it is important to note that Exhibit "A" contains the pictures of 27 different marks/labels of pens manufactured by the Plaintiffs. Not one of them bears the trade mark "Pin Point".

25. The Plaintiffs have therefore failed to establish any case on the basis of passing off.

26. Mr.Tulzapurkar also resisted the case of passing off on other grounds including the ground that the Plaintiffs had themselves pirated the entire design and get up from other manufacturers. He relied upon the judgments including of this Court which hold that the infringer is himself not entitled to an injunction on the basis of passing off. In view of the fact that the Plaintiffs have not established any reputation or goodwill I do not find it necessary to go into these questions either.

27. In the circumstances the Notice of Motion is dismissed. The Defendants are however ordered and directed to maintain accounts. There shall be no order as to costs.